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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.                        | CONFIRMATION NO.        |
|---|-------------|----------------------|--|-------------------------|
| 10/789,610  | 02/27/2004  | Roy K. Lim           | 4002-3438                                  | 9038                    |
| <div>7590      03/19/2007<br/>Woodard, Emhardt, Moriarty, McNett &amp; Henry LLP<br/>Bank One Center/Tower<br/>Suite 3700<br/>111 Monument Circle<br/>Indianapolis, IN 46204-5137</div> |             |                      | <div>EXAMINER<br/>REIMERS, ANNETTE R</div> |                         |
|   |             |                      | <div>ART UNIT<br/>3733</div>               | <div>PAPER NUMBER</div> |
| SHORTENED STATUTORY PERIOD OF RESPONSE  |             |                      | MAIL DATE                                  |                         |
| 3 MONTHS  |             |                      | 03/19/2007                                 |                         |
|   |             |                      | DELIVERY MODE                              |                         |
|   |             |                      | PAPER                                      |                         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/789,610

Applicant(s)

LIM, ROY K.

Examiner

Annette R. Reimers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-31 and 42-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-12, 15-31, 42-47, 50-67, 69 and 70 is/are rejected.
- 7) ☒ Claim(s) 13, 14, 48, 49 and 68 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Upon further consideration, the final office action mailed on November 16, 2006 has been vacated. A new rejection follows.

#### ***Allowable Subject Matter***

The indicated allowability of objected claims 3-12, 15-31, 42-47 and 50-67 is withdrawn. Rejections based on the newly cited reference follow.

#### ***Specification***

The disclosure is objected to because of the following informalities: On page 5, line 14, of the specification, shaft should have reference number 28 not 24. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3-12, 15-31, 42-47, 50-67 and 69-70 are rejected under 35 U.S.C. 102(b) as being anticipated by Koros et al. (US Patent Number 5,273,519)

Koros et al. disclose various embodiments of an apparatus for connecting to an orthopedic implant comprising a base comprising an upper base portion and a lower base portion (see various embodiments of figures 2, 19 and 23) and having a relatively forward end and a relatively rearward end, a closure with a latch, e.g. 60, connected to

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the upper base portion and the lower base portion (see various embodiments of figures 2, 4, 5, 6, 6A, 9, 19, 21, 22 and 23) a slidable shaft, e.g. 30, connected to the base, wherein the shaft includes an elongated portion, e.g. 172, and a plunger portion with a groove, e.g. 174, connected to each other, and two concentric springs, e.g. 68 and 66 (see column 11, lines 1-11) abutting the plunger, a lever/slider, e.g. 65, connected to the shaft, a pivotable plate comprising a roughened surface and a tapered aperture, e.g. 122, (see various embodiments disclosed in figures 4, 5, 6, 6A, 9, 21 and 22), for claims 42, 55, 58, 59, 60, 61, 66 and 67, in a different interpretation, 150 and 160, can be considered the pivotable plate (see figures 16-18), wherein the plate includes a rounded surface and the shaft includes an indentation and the indentation and the rounded surface are adjacent each other (see various embodiments disclosed in figures 4, 5, 6, 6A, 9, 21 and 22 and figures 16-18), a sleeve, e.g. 25, 26 and 27, at least partially surrounding the shaft and being slidable via 70 and 75 along the shaft and slidable with respect to the base and the plate (see various embodiments of figures 4, 5, 6, 6A, 9, 21 and 22 and column 4, lines 22-23 and 28-31), a ratchet mechanism (see figures 10 and 11) connected to the base and the sleeve, wherein the ratchet mechanism is operable to move the sleeve with respect to the base, the shaft and the plate (see various embodiments of figures 4, 5, 6, 6A, 9, 10, 11, 21 and 22), a stop connected to the base comprising at least one pawl (see figures 10 and 11) that is pivotable between at least one position connected to the ratchet mechanism and the position disengaged from the ratchet mechanism and a handle including an actuator, e.g. 22, movably/pivotably connected to the base, wherein the actuator operates the ratchet mechanism when the

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actuator is moved relative to the base. The handle further comprises a rigid stock, e.g. 10, at least one leaf spring, 40 (see various embodiments of figures 2, 4, 5, 6, 6A, 19 and 23). Koros et al. also disclose two leaf springs (see figure 1).

With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Koros et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Allowable Subject Matter***

Claims 13-14, 48-49 and 68 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments with respect to claims 3-31 and 42-70 have been considered but are moot in view of the new ground(s) of rejection.

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***Conclusion***

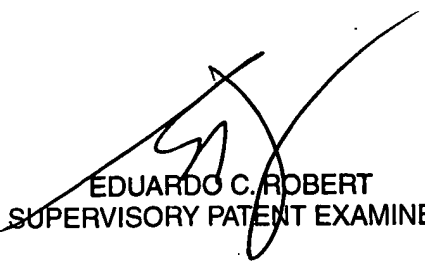
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 for art cited of interest

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER